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22879 7590 12/24/2008 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400				
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* SHELL S. SIMPSON

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Appeal 2008-1682  
Application 09/923,328  
Technology Center 2100

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Decided: December 22, 2008

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*Before* LANCE LEONARD BARRY, HOWARD B. BLANKENSHIP, and  
THU A. DANG, *Administrative Patent Judges*.

DANG, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

Appellant appeals under 35 U.S.C. § 134 from a final rejection of claims 1-37. We have jurisdiction under 35 U.S.C. § 6(b).

#### A. INVENTION

According to Appellant, the invention generally relates to performing web imaging operations, and more particularly, to determining the status of web-based jobs (Spec. 1, ¶ [0001]).

#### B. ILLUSTRATIVE CLAIM

Claim 1 is exemplary and is reproduced below:

1. A method for monitoring a web-based service, comprising the steps of:

receiving automatically at a client a service reference to a status of a job in a network service;

adding the service reference to a bookmark list on the client; and

removing automatically the service reference from the bookmark list on the client when the job is completed by the network service.

#### C. REJECTIONS

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Treptow	US 2002/0138564 A1	Sep. 26, 2002
Lahey	US 2005/0228711 A1	Oct. 13, 2005

Claims 1-37 stand rejected under 35 U.S.C. § 103(a) over the teachings of Treptow and Lahey.

We affirm.

## II. ISSUE

The issue is whether Appellant has shown that the Examiner erred in finding that claims 1-37 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Treptow and Lahey. In particular, the issue turns on whether the combination of Treptow and Lahey discloses “receiving automatically at a client a service reference to a status of a job in a network service” and “adding the service reference to a bookmark list on the client” (Claim 1).

## III. FINDINGS OF FACT

The following Findings of Fact (FF) are shown by a preponderance of the evidence.

### *Treptow*

1. A user may review the status of a requested print job via activation of my print status tab 136, which will render a Consumer Web page 166 displaying various print status information, including print job name 168, progress bar 170, and printing status 172 (p. 4, ¶ [0062]; Fig. 5).
2. Job Status refers to the status of a job request that indicates the current progress of the request processing, wherein users are aided in understanding the status of their job requests (p. 3, ¶ [0041]).
3. Consumer web pages comprise standard HTML Web pages that are viewed by a Web browser, and may include WML, HDML, or cHTML pages to support WAP and i-mode-enabled wireless devices such as wireless PDA's and cell phones. (p. 4, ¶ [0058]).

4. Activation of print jobs tab 230 includes view print queue tab 242 and list by owner tab 246, wherein the print queue tab 242 enables viewing of pending print jobs for a printer that is selected via a pull down control 254 (p. 7, ¶ [0088]; Fig. 9).
5. Activation of all jobs tab 250 enables viewing of information pertaining to all jobs printed through a particular Driverless Printer Server (DPS), as depicted by an Administrative Panel Web page 292, wherein navigation between records is enabled via a set of navigation controls 294 (p. 7, ¶ [0092]; Fig. 13).
6. During the print process, Status Monitor 116 monitors the progress of the process and updates DPS database 386, wherein status CGI-script 204 is used to provide Web page print status information by retrieving the progress information from the database and generating appropriate HTML to cause the progress information to be displayed in the Web page (p. 9, ¶ [0105]; Fig. 17).

*Lahey*

7. Lahey discloses a clean-up worker used to delete jobs that have remained in the job status table for a predetermined period of time or that have completed status, wherein the clean-up worker deletes all job-related files and information and the database records for the jobs (p. 8, ¶ [0077]).

#### IV. PRINCIPLES OF LAW

##### *35 U.S.C. § 103(a)*

Section 103 forbids issuance of a patent when “the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.”

*KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007).

In *KSR*, the Supreme Court noted that “[c]ommon sense teaches . . . that familiar items may have obvious uses beyond their primary purposes, and in many cases a person of ordinary skill will be able to fit the teachings of multiple patents together like pieces of a puzzle.” *KSR*, 127 S. Ct. at 1742. “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” *Id.*

“[T]he PTO gives claims their ‘broadest reasonable interpretation.’” *In re Bigio*, 381 F.3d 1320, 1324 (Fed. Cir. 2004) (quoting *In re Hyatt*, 211 F.3d 1367, 1372 (Fed. Cir. 2000)). “Moreover, limitations are not to be read into the claims from the specification.” *In re Van Geuns*, 988 F.2d 1181, 1184 (Fed. Cir. 1993) (citing *In re Zletz*, 893 F.2d 319, 321 (Fed. Cir. 1989)). Our reviewing court has repeatedly warned against confining the claims to specific embodiments described in the specification. *Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005) (en banc).

When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art

in terms of patentability. *In re Ngai*, 367 F.3d 1336, 1339 (Fed. Cir. 2004).  
*Cf. In re Gulack*, 703 F.2d 1381, 1385 (Fed. Cir. 1983).

## V. ANALYSIS

Since Appellants provide arguments for claim 1 and claim 5 in the Appeal Brief, and no other arguments for separate patentability, we will decide the appeal on the basis of claim 1 and claim 5. *See* 37 C.F.R. § 41.37(c)(1)(vii).

### *Prima facie case of obviousness*

Appellant argues that Treptow does not teach or suggest “receiving automatically at a client a service reference to a status of a job in a network service or adding the service reference to a bookmark list on the client” (App. Br. 6) because, in Treptow, “the client in some fashion receives an URL or some other reference for that web page” and “Treptow makes no indication that the URL for the web page is received automatically at a client or added to a bookmark list on that client” (*Id.*). The Examiner finds that Treptow in view of Lahey discloses such limitations (Ans. 4). Therefore, the specific issue is whether the Appellant has shown error in the Examiner’s finding that the combination of Treptow and Lahey discloses “receiving automatically at a client a service reference to a status of a job in a network service” and “adding the service reference to a bookmark list on the client” (Claim 1).

We generally agree with the Examiner's finding that Treptow and Lahey disclose the claimed limitations beginning at page 4 of the Answer, and including the Examiner's response to arguments beginning at page 8 of the Answer.

Treptow discloses a Status Monitor at a client that monitors the status of a job in a network service using Status CGI-script (FF 6) and then the job status is added to a status list (FF 1-5). Lahey discloses deleting a job status from the status list when the job is completed (FF 7). We find that one of ordinary skill in the art would have understood the monitoring of job status by the Status Monitor using Status CGI-script at the client and adding the job status to the status list of Treptow to be automatically receiving at a client a service reference and adding the service reference to a bookmark list. We thus agree with the Examiner that Treptow in view of Lahey disclose "receiving automatically at a client a service reference to a status of a job in a network service; adding the service reference to a bookmark list on the client; and removing automatically the service reference from the bookmark list on the client when the job is completed by the network service" (Claim 1). That is, an artisan would have been able to fit the circuits of Treptow and Lahey together like pieces of a puzzle since a person of ordinary skill is also a person of ordinary creativity, not an automaton. *See KSR*, 127 S. Ct. at 1742.

As the Examiner finds, "Appellant's specification merely uses the work 'automatically' but is silent as about what factors or component make



the function automatic” (Ans. 8). We agree. The term “automatically” cannot be confined to a specific embodiment when the claims do not recite such specific embodiment. We thus construe the term “automatically” by giving the term its customary and ordinary meaning of “without external influence or control.”

An artisan would have understood that the Status Monitor of Treptow monitors the status without external influence or control. Accordingly, we agree with the Examiner that “Treptow discloses procedure of receiving a service reference to the status of the job at a client is in fact an automatic procedure based on the ‘Status CGI-Script’ program” (Ans. 9).

In the Reply Brief, Appellant adds the argument that, according to Appellant’s paragraph [0181], “a book mark list is a bookmark list provided in a browser” (Reply Br. 3). As the Examiner finds, “appellant’s ‘bookmark list’ is basically a ‘list’ of job/tasks associated with a user” and “[b]y merely calling a ‘job/task list’ a ‘bookmark list’ does not entitle appellants invention to be patentable” (Ans. 10).

We agree with the Examiner. The term “bookmark list” cannot be confined to a specific embodiment when the claims do not recite a specific embodiment. Furthermore, Treptow discloses that the job status is added to a list on a Consumer Web page which displays various print status information, wherein the Consumer web page comprises a standard HTML Web page that are viewed by a Web browser. An artisan would have understood the list accessed by linking to the HTML Web page of Treptow

to be a bookmark list accessed by a browser at the client. Accordingly, we agree with the Examiner that Treptow discloses “adding the service reference to a bookmark list on the client” (Claim 1).

Further, the term “bookmark” is not functionally related to the step of “adding a service reference” but is merely a label set forth to indicate that the service reference is added to a particular list. Thus, we agree with the Examiner that such “bookmark” label will not distinguish the invention from the prior art in terms of patentability. *See In re Ngai*, 367 F.3d at 1339 and *In re Gulack*, 703 F.2d at 1385.

Accordingly, we conclude that the Appellant has not shown that the Examiner erred in rejecting claim 1 under 35 U.S.C. § 103(a).

As to claim 5, Appellant further contends that “[n]either Treptow nor Lahey mentions a personal imaging repository in an autonomous network service,” and draws the Examiner’s attention to paragraph [0061] of Appellant’s Specification for a definition of “personal imaging repository” (App. Br. 7). However, the Examiner finds that Appellant’s Specification defines “personal imaging repository” as “any type of or combination of data storage device” and thus “RAM [as disclosed by Treptow] falls under the vague explanation ‘any type of or combination of data storage device’ as disclosed by the applicant in his specification cited above” (Ans. 12). Appellant provides no argument to dispute that the Examiner has correctly shown where all the claimed elements appear in the prior art. Accordingly,

we conclude that Appellant has not shown that the Examiner erred in rejecting claim 5 under 35 U.S.C. § 103(a).

We therefore sustain the Examiner's rejection of claims 1 and 5 under 35 U.S.C. § 103(a), and of claims 2-4 and 6-37, which fall with claim 1 or claim 5.

#### CONCLUSION OF LAW

(1) Appellant has not shown that the Examiner erred in finding that claims 1-37 are unpatentable under 35 U.S.C. § 103(a) over the teachings of Bedford and Molnar.

(2) Claims 1-37 are not patentable.

#### DECISION

The Examiner's rejection of claims 1-37 under 35 U.S.C. § 103(a) is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

Appeal 2008-1682  
Application 09/923,328

msc

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